

REMARKS

Claims 1-7 and 9-11 are pending in the current application. A fourth declaration of inventor Martin Melchior ("the fourth declaration") is submitted herewith under Rule 1.132.

Rejection Under 35 U.S.C. § 103

Claims 1-7 and 9-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,126,393 ("Blum") in view of EP 0 159 117 B1 ("Hughes"). Applicants respectfully traverse this rejection.

Claim 1 of the present invention is directed to an aqueous coating composition prepared as a dispersion in which a urethane-modified polyol and a pyrazole-blocked polyisocyanate are mixed together prior to preparation of the aqueous dispersion.

It is asserted in the Office Action that previous arguments and declarations are not adequately representative of the prior art, because the prior art does not require that the crosslinking agent be added after formation of the dispersion. This assertion is based on one sentence in the Blum disclosure which states that the ingredients can be added in any order, which is said to be "clear on its face". It is also asserted that the comparative examples provided in the previous declarations are not adequately representative of the prior art, because a different polyester and diisocyanate are used. Finally, it is further asserted that Hughes establishes that the skilled artisan knew how to utilize the claimed blocking agents in aqueous systems. Applicants respectfully disagree with this characterization of the Blum and Hughes references, and the characterization of the comparative date, for the following reasons.

1. A reference must be read from the point of view of the skilled artisan. It is well established in the law that the teachings of a patent are directed to one skilled in the art, not an ordinary person. A prior art reference must be interpreted from the point of view of a skilled artisan. See, e.g., *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989) ("A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art" (emphasis added)); and *Kimberly-Clark Corp. v.*

Johnson & Johnson, 745 F.2d 1437, 1453, 223 USPQ 603, 612-14 (Fed. Cir. 1984). The Blum and Hughes references, as applied by the Examiner, would not be interpreted in the manner suggested in the Office Actions.

As established in the fourth declaration of Dr. Martin Melchior, at the time of the present invention aqueous dispersions were not prepared in the manner suggested by the Examiner; typically, a urethane-modified polyol was prepared in an aqueous dispersion, to which the crosslinker was added. One skilled in the art would interpret the disclosure of Blum in view of the examples presented, all of which show preparation of the dispersion first, and addition of the cross-linker second. Additionally, melamine resins are dispersible in water, whereas blocked polyisocyanates are not, as would be known by one skilled in the art. Blum does not use any blocked polyisocyanates, and therefore the teachings of Blum would say nothing to the skilled artisan about how to incorporate blocked isocyanates into an aqueous dispersion.

It is asserted that Hughes provides evidence that one skilled in the art knew how to accomplish this. This is an incorrect reading of Hughes, which does not provide any examples at all on the preparation of a dispersion. The one sentence cited to in Hughes, at page 4, lines 4-5, states "These paints are usually composed of a pigment dispersed in an aqueous dispersion of a resin containing active hydrogen ***which is to be crosslinked by the polyisocyanate*** (emphasis added)". This sentence in fact indicates that Hughes shows addition of the blocked cross-linker after the creation of the dispersion, not before, as asserted in the Office Action.

One sentence in each reference is relied upon as a basis for asserting that the present invention is obvious, in spite of the fact that caselaw and precedent, ignored by the Examiner, specifically address this situation and instruct the opposite conclusion, namely, that a single line in a prior art reference should not be taken out of context and relied upon with the benefit of hindsight to show obviousness. As previously noted in the previous response, the Court of Customs and Patent Appeals cautioned that "it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *in re Wesslau*, 353 F. 2d 238, 147

USPQ 391 (CCPA 1965). The Examiner picks one sentence from each reference to support his position, to the exclusion of the other parts necessary to understand what the references in fact teach. As established in the Declaration of Dr. Melchior, both the Blum and Hughes references as a whole, and as would be read and understood by one skilled in the art, teach addition of the cross-linker after preparation of the aqueous dispersion, and say nothing to one skilled in the art about how to incorporate a blocked polyisocyanate into an aqueous dispersion.

2. The comparative data are representative of the relied-upon art, and are commensurate in scope with the presently claimed invention.

The examples in the application show use of aliphatic polycarbonate polyesters; the first declaration showed use of polyester polyol and aliphatic polyisocyanate; and the second/third declarations show use of aromatic polyisocyanates in combination with linear aliphatic polyethers. Thus, both aliphatic and aromatic isocyanates have been demonstrated, and polycarbonate, polyester, and polyether polyols have been shown. The present invention clearly works in all categories claimed. Criticality of the order of addition has also been demonstrated: following the method taught in the examples of Blum, one cannot add the blocked polyisocyanates of the present invention after creation of the dispersion and obtain a suitable coating.

It is now asserted in the Office Action that because Applicants have not used the exact polyester and diisocyanate shown in Blum that the comparative data are not representative of the prior art. This notion is absurd. Example D4 of the present invention on page 17 describes use of a polyester prepared from adipic acid and hexanediol, which is mixed with dimethylolpropionic acid, hexane 1,6-diol and N-methylpyrrolidone, which is then further reacted with isophorone diisocyanate to prepare the urethane-modified polyol. These ingredients are almost identical to those used in Blum, Example 1, to prepare the urethane-modified polyol of that invention. The present compositions cannot be directly compared to Blum because Blum uses a melamine resin cross-linker which is not blocked, and which is not used in the present invention. Additionally, as pointed out in the Declaration by Dr. Melchior, and as known in the art, melamine resin is easily dispersible in water, whereas blocked polyisocyanates are not. The differences between the present

invention and the composition taught by Blum are not due to the difference in specific polyol or specific isocyanate used to prepare the urethane-modified polyol, but due to the method of making the dispersion, and the addition of blocked cross-linker. One skilled in the art would reasonably conclude that any of the claimed polyisocyanates and polyols would provide the desired properties and behave similarly in the method of preparation, as shown in the comparative examples.

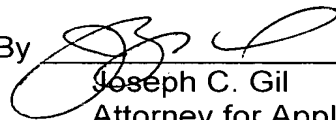
Applicants have amply demonstrated that the presently claimed invention is not taught or suggested by any of the cited references. Only with the hindsight provided by the present invention would one skilled in the art conclude that a stable dispersion could be achieved in the manner recited in Claim 1. Applicants respectfully request withdrawal of the §103 rejection of Claims 1-7 and 9-11.

Conclusion

As all outstanding issues have been addressed, Applicants submit that Claims 1-7 and 9-11 are in condition for allowance; such action is respectfully requested at an early date.

Respectfully submitted,

By



Joseph C. Gil
Attorney for Applicants
Reg. No. 26,602

Bayer MaterialScience LLC
100 Bayer Road
Pittsburgh, Pennsylvania 15205-9741
(412) 777-3813
FACSIMILE PHONE NUMBER:
(412) 777-3902

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